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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
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10/086,584

02/28/2002

Robert J. Ward

INVSC.4

9027

7590

08/16/2006

Robert J. Ward
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EXAMINER

MAI, TRI M

ART UNIT

PAPER NUMBER

3727

DATE MAILED: 08/16/2006

Please find below and/or attached an Office communication concerning this application or proceeding.

SP

Office Action Summary	Application No.		Applicant(s)	
	10/086,584		WARD ET AL.	
	Examiner		Art Unit	
	Tri M. Mai		3727	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☐ Responsive to communication(s) filed on ____.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 44-48, 54 and 60 is/are pending in the application.
- 4a) Of the above claim(s) ____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) ____ is/are allowed.
- 6) ☒ Claim(s) 44-48, 54 and 60 is/are rejected.
- 7) ☐ Claim(s) ____ is/are objected to.
- 8) ☐ Claim(s) ____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on ____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. ____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).
- * See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413)
Paper No(s)/Mail Date. ____. |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | 5) <input type="checkbox"/> Notice of Informal Patent Application (PTO-152) |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO-1449 or PTO/SB/08)
Paper No(s)/Mail Date ____. | 6) <input type="checkbox"/> Other: ____. |

DETAILED ACTION

1. Claims 44, 45, 46, 54, and 60 are rejected under 35 U.S.C. 103(a) as being unpatentable over Eckstein (5203390) in view of Shih (6138727), and further in view of either Chapman (1957577) or Hendren (5813080). Eckstein teaches an apparatus having an outer layer 18 of waterproof material (col. 3, ln. 5) having a top portion, a bottom portion, and a middle portion, an interior surface and an opening formed at the bottom position, an internal volume, a moisture absorbent member 30 positioned within the volume of the outer foam layer adjacent the middle portion of the interior surface. It is noted that the inner layer would have an open top end when the three edges 22, 24 and 26 are stitched together to form the cover. Eckstein meets all claimed limitations except for the material being a foam material and the hook element.

Either Chapman or Hendren teaches that it is known in the art to provide a hook element 10, 26 respectively. It would have been obvious to one of ordinary skill in the art to provide a hook element in Eckstein as taught by Chapman or Hendren to secure the device to the golf bag easily.

With respect to the material being a foam material, Shih teaches that it is known in the art to make a cover from foam material. It would have been obvious to one of ordinary skill in the art to make the outer layer from foam material in Eckstein as taught by Shih to provide the desired material for the outer layer.

Regarding claim 60, note the opening would have an elliptical shape when the closure 16 is in a relaxed state.

2. Claims 47 and 48 are rejected under 35 U.S.C. 103(a) as being unpatentable over the Eckstein rejection, as set forth above, and further in view of Solheim (4667716). It would have

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been obvious to one of ordinary skill in the art to make the cover from closed-cell foam material as taught by Solheim to provide an alternative material.

Regarding claim 48, it would have been obvious to one of ordinary skill in the art to provide a logo on the exterior surface as taught by Solheim, col. 2, ln 10-14, to advertise the product.

3. Applicant's arguments with respect to the claims have been considered but they are not persuasive. It is noted that the correct patent number for Chapman is U.S. 1,957,577.

Applicant asserts that Eckstein teaches away from the present invention by requiring a retainer, e.g. drawings at the open end. The examiner submits that the limitation wherein "the shaft of the golf club **may be** inserted into the opening....and the outer foam layer operable to be squeezed to contact the moisture absorbent" is an intended use recitation. **A recitation of the intended use of the claimed invention must result in a structural difference between the claimed invention and the prior art in order to patentably distinguish the claimed invention from the prior art.** If the prior art structure is capable of performing the intended use, then it meets the claim. In this case, the invention is broadly set forth as an "apparatus" and the apparatus as claimed does not impart any structure over the cover in Chapman. Furthermore, it is noted that the claim recites "comprising", which does not exclude other elements into the claims.

Furthermore, it is noted that the cover of Eckstein is clearly capable of the intended use, i.e., prior to the securing of the drawstring, one can utilize the cover in the intended manner.

4. **THIS ACTION IS MADE FINAL.** Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

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A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

5. Any inquiry concerning this communication or earlier communications from the examiner should be directed to Tri M. Mai whose telephone number is (571)272-4541. The examiner can normally be reached on 7:30am-5:00pm.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Nathan Newhouse can be reached on (571)272-4544. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free).

Tri M. Mai
Primary Examiner
Art Unit 3727

